

REMARKS

The present invention is directed to control valves in which flow capacity may be easily varied and controlled. In one embodiment, the invention involves a ball valve and a disk, wherein the disk has a specially shaped opening, such that the opening in the disk interacts with the passage through the ball valve in such a way that desired flow characteristics are achieved. For example, by use of an appropriately shaped opening in the disk, it is possible to achieve equal percent flow through the passage in the valve as the ball is turned from an open to a closed position.

This is a reissue application filed for the purpose of provoking an interference and contains only previously allowed claims from Applicants' U.S. Patent 6,039,304 and U.S. Patent 5,937,890 (the '890 patent to Mirandi). No claims have been added, cancelled or amended.

STATUS

Claims 1-9, which are claims contained in Applicants' issued U.S. Patent 6,039,304 have been allowed. Similarly, the Examiner has allowed an amendment to the Specification to permit a claim of priority to a copending U.S. Provisional Application.

Claims 10-42 which are the claims Applicants' copied from Mirandi, U.S. 5,937,890 for the purpose of provoking an interference all stand rejected.

In response to a First Office Action, Applicants filed a comprehensive response. A Final Rejection followed, which repeated the entire substance of the First Office Action. Rather than repeat the entire substance of their response to the First Office Action, which Applicants believe is still fully pertinent and responsive to the positions repeated by the Examiner in the Final Rejection, Applicants will simply provide an abbreviated summary of the status of this application and will provide certain additional Remarks. However, since Applicants' Response to the First Office Action is believed to be still pertinent and relevant, it is incorporated herein by reference as if fully repeated herein.

The Rejections

There are presently five (5) separate grounds of rejection being asserted by the Examiner against various of the claims which Applicants copied from the Mirandi patent. These rejections were all contained in the First Office Action and were repeated unchanged, in the Final Rejection.

35 U.S.C. § 251

All pending claims copied from the Mirandi patent have been rejected under 35 U.S.C. § 251. These claims can be divided into two groups:

1. A group of thirty (30) claims, claims 10-17, 19, 20, 22 and 24-42, have been rejected under 35 U.S.C. § 251 as being based on new matter added to the patent for which reissue is sought.

2. The three (3) claims copied from Mirandi and not rejected as being based on new matter, claims 18, 21 and 23, have been rejected under 35 U.S.C. § 251 as being an improper recapture of subject matter surrendered in the application for the patent upon which the present reissue is based.

35 U.S.C. § 112

3. A group of thirty (30) claims has been rejected under 35 U.S.C. § 112 first paragraph as containing subject matter not supported in the specification. These claims are the same claims, (claims 10-17, 19, 20, 22 and 24-42) which were rejected under Section 251 as being based on new matter.

35 U.S.C. § 102(b)

4. Two of the copied Mirandi claims from the group rejected under 35 U.S.C. § 112 paragraph 1 and 35 U.S.C. § 251 as containing new matter have also been rejected under 35 U.S.C. § 102(b) as anticipated by Scaramucci. These are claims 39 and 40.

35 U.S.C. § 103(a)

5. Five of the copied Mirandi claims have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Scaramucci. These are claims 18, 21 and 23-25. This group includes the three (3) pending claims from Mirandi not rejected under 35 U.S.C. § 112 paragraph 1, (claims 18, 21 and 23), as well as two (2) other claims, (claims 24 and 25).

Applicants' position as to these rejections is set forth in full in response to the First Office Action. It may be summarized as follows:

As to the claims which are deemed to contain new matter, Applicants respectively urge that the Examiner is applying an improper standard. The Examiner dismisses Applicants' arguments regarding new matter and supporting disclosure by saying that the "argument that a claim limitation should be considered disclosed if not disclosed (but considered obvious) is not persuasive". However, for purposes of provoking an interference, Applicants are routinely permitted to suggest counts (copy claims) which contain limitations not found in Applicants' disclosure, so long as the limitations are not material to patentability. See 37 C.F.R. 1.606. If the Examiner disagrees with Applicants' position as to the presence of supporting disclosure in Applicants' underlying patent for certain of the limitations found in Applicants' copied claims, it is incumbent upon the Examiner to suggest alternative counts. See generally the MPEP at 2305.

The Examiner openly admits that there is overlapping claimed subject matter as between the Mirandi patent claims and at least some of those copied claims in the reissue application. In particular, the Examiner has not rejected claims 18, 21 and 23 under 35 U.S.C. § 112 as containing new matter. Thus, the Examiner clearly concurs with Applicants that for at least these three claims there is support in Applicants' Specification. However, the Examiner has refused to declare an interference as to those claims by contending that those three claims may be rejected based on both the "recapture doctrine" and over prior art.

THE RECAPTURE REJECTION

Applicants believe that the recapture doctrine is clearly inapplicable here and is not consistent with the controlling case law. Recapture is intended to preclude an applicant from obtaining reissue claims which are of the same scope as claims which the applicant may have conceded were unpatentable by virtue of amendments made during the prosecution of the issued patent. The leading case explaining and applying the recapture doctrine is *Ball Corp. v. United States*, 729 F.2d 1429, 221 U.S.P.Q. 289 (Fed. Cir. 1984), which was indeed cited and relied upon by the Examiner. A reading of *Ball* makes clear, however that application of the recapture doctrine is unwarranted here.

Applicants amended their claims in now issued U.S. Patent 6,039,304 to insert a claim limitation directed to means for holding in place the disk which controls flow through the ball

valve passage. However, the now pending claims, against which recapture is asserted, are not equal in scope to the pending claims to which Applicants added the referenced limitation in the issued patent. Rather, the claims against which the Examiner has asserted recapture are narrower in some respects and broader in other respects than were Applicants' initial claims. *Ball*, as well as the other cases cited by the Examiner, *In re Clement*, 131 F. 3d 1464, 45 U.S.P.Q. 2d 1161 (Fed. Cir. 1997) and *Hester Industries, Inc. v. Stein, Inc.*, 142 F. 3d 1472, 46 U.S.P.Q. 2d 1641 (Fed. Cir. 1998), hold that in such circumstances recapture does not automatically apply.

As explained in *Ball*, the recapture doctrine is intended to prevent applicants from using the reissue procedure as a substitute for appeal. In other words, applicants should not, in lieu of appeal, be permitted to cancel claim limitations to secure allowance and then file for reissue to try to secure claims of the original scope. Rather, as *Ball* states, "Reissue is an extraordinary procedure and must be adequately supported by the circumstances...". 221 U.S.P.Q. at 293. The circumstances here are not in dispute. Applicants filed this reissue for the clear and obvious purpose of provoking an interference, not to remove a particular claim limitation from their issued patent.

In *Ball* the CAFC rejected rigid application of the recapture doctrine, and emphasized that recapture was an equitable doctrine, requiring analysis of particular factual situations. In *Ball* the CAFC permitted a reissue applicant to proceed with claims which were narrower in

some respects and broader in other respects than were the claims in the issued patent.

Clearly, Applicants' claims 18, 21 and 23 are claims which the *Ball* Court would not have rejected based on recapture.

Equitable factors here dictate that the recapture doctrine not be applied. In addition to the circumstance that this reissue was filed for the sole purpose of provoking an interference and not to reargue prior art, the prior art here at issue is not even the same art as was applied against Applicants' claims in their original patent application.

Moreover, the claims against which recapture is asserted, claims 18, 21 and 23, contain limitations not found in claims 1, 4 and 6 of Applicants' issued patent, which are the claims amended during the prosecution of the original patent. In other words, pending claims 18, 21 and 23 are broader in some aspects and narrower in other aspects than are claims 1, 4 and 6 of Applicants' issued patent.

Accordingly, the very cases cited by the Examiner on the issue of recapture do not support, and in fact are at odds with, the present recapture rejection.

THE PRIOR ART REJECTIONS

As to the prior art rejection, Applicants respectfully urge that it was improper for the Examiner to make the prior art rejection Final, as the Group Director did not approve this rejection in the First Office Action, as is required by Patent Office regulations. MPEP 2307.02. Accordingly, at a minimum, a Final Rejection of claims copied from the Mirandi patent based on the cited prior art is premature. Applicants suggest that the prior art rejection either be withdrawn for now, and resolved in the context of an interference, or that the Final Rejection in view of the prior art be suspended as improvidently issued. In their Response to the First Office Action applicants' noted that a Final Rejection in view of the prior art would be premature, were it to be contained in the next Office Action.

Regarding the merits of the prior art rejection, Applicants continue to urge that the patentability of the claims copied from the Mirandi patent should be determined in an interference proceeding, which is the most appropriate form for resolving the priority dispute between an issued patent and an application.

CONCLUSION

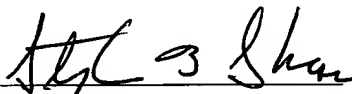
The MPEP at Chapter 2306 is quite explicit:

"In all cases the examiner should keep in mind that the issuance of two patents for inventions which are either identical to or not patentably distinct from each other must be avoided."

In this case, the Examiner has recognized that there is overlapping subject matter as between the claims of the issued patent and certain fully supported claims in the reissue application. It is now improper for the Examiner to grasp for tenuous grounds on which to reject the reissue claims, solely for the purpose of preventing an interference, which proceeding could resolve in an equitable fashion all of the outstanding issues which this reissue application presents.

Respectfully submitted,

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